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JUN 14 2001

**OFFICE OF PETITIONS
A/C PATENTS**

In re Application of
Sackstein
Application No. 09/619,290
Filed: July 19, 2000
For: SULFATION-INDEPENDENT L-
SELECTIN OR E-SELECTIN LIGAND
(HCELL) AND THERAPEUTICS THEREOF

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(b)

This is in response to the petition under 37 CFR 1.47(b), filed April 13, 2001, and accompanied by a petition for a five month extension of time and within the maximum extendable time for reply from the Notice to File Missing Parts mailed September 13, 2000.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to respond, correcting the below-noted deficiencies. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)" and may include an oath or declaration executed by the inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on July 19, 2000 without an executed oath or declaration and naming Sackstein as the sole inventor.

Accordingly, on September 13, 2000, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on April 13, 2001, a Response to the Notice to File Missing Parts was filed which contained the following items:

1) Unexecuted Declaration and Power of Attorney with an added page for Signature by Person with Sufficient Proprietary Interest on Behalf of

Nonsigning Inventor who Refuses to sign or Cannot be Reached and associated surcharge late fee;

- 2) a copy of the Notice to File Missing Parts;
- 3) petition for five month extension of time and associated fee;
- 4) Petition under 37 CFR 1.47(b) including a Statement Establishing Proprietary Interest by Person Signing on Behalf of Nonsigning Inventor;
- 5) a Statement of Facts in support of the 37 CFR 1.47(b) Petition; and
- 6) a general authorization to charge any additional fees or credit any overpayments to deposit account no. 11-1449.

On April 13, 2001, an unexecuted Declaration and Power of Attorney accompanied by an added page for Signature by Person with Sufficient Proprietary Interest on Behalf of Nonsigning Inventor who Refuses to sign or Cannot be Reached signed by Kenneth G. Preston on behalf of Robert Sackstein was filed.

A grantable petition under 37 CFR 1.47(b) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration;
- (2) an acceptable oath or declaration;
- (3) the petition fee;
- (4) a statement of the last known address of the non-signing inventor;
- (5) proof of proprietary interest; and
- (6) proof of irreparable damage.

Applicant lacks item (1), (5) and (6) set forth above.

As to item (1), Before an inventor can refuse to sign an oath or declaration, he must have been presented with a copy of the application papers (specification, claims and drawings). See Manual of Patent Examining Procedure, Section 409.03(d). Petitioner should show that a copy of the application papers was presented to the inventor, but that he did not respond to the request that he sign the oath/declaration in order to show that the inventor has refused to join in the application. Ms. Rinaldi merely

states that Mr. Sackstein has repeatedly refused to sign the documentation (i.e. Declaration and Power of Attorney). There is no evidentiary support that the documentation included the application papers. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events. Accordingly, Rule 47 applicant failed to show or provide proof that the inventor has refused to sign the declaration.

As to item (5), Rule 47 applicant failed to show or provide proof that University of South Florida; Mr. Kenneth G. Preston, assistant Vice President, Office of Research, has sufficient proprietary interest in the subject matter to justify the filing of the application (see MPEP 409.03(f)). Acceptable proof would include a copy of the employment agreement between the non-signing inventor and the University of South Florida, a copy of an assignment agreement showing that the invention disclosed in the application is assigned to the Rule 47(b) applicant, or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to the Rule 47(b) applicant.

As to item (6), Rule 47 applicant failed to provide proof of irreparable damage (see MPEP 409.03(g)). A statement by Rule 47 applicant that the filing is necessary to preserve the rights of the parties to prevent irreparable damage would be sufficient.

Petitioner's deposit account No. 11-1449 has been charged the required \$130 petition fee since said fee was not specifically provided and a general authorization was.

Further correspondence with respect to this matter should be addressed as follows:

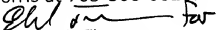
By mail: Assistant Commissioner for Patents
Box DAC
Washington, DC 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place

Crystal Plaza 4, Suite 3C23
Arlington, VA

Telephone inquiries related to this decision should be directed to Lesley
Morris at 703-306-0028.


Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy